Supreme Court, U.S.
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No.

In the Supreme Court of the United States

TECHSEARCH, L.L.C.,

Petitioner,

v.

INTEL CORPORATION,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

In this decision, the Federal Circuit was called upon for the first time to consider the propriety of a district court's *sua sponte* appointment of a "technical advisor." Ignoring its mandate to ensure uniformity of application of the patent statute, the Federal Circuit looked to Ninth Circuit law (which conflicts with decisions of other circuits) to conclude that the district court acted properly by disregarding Fed.R.Evid. 706(a) and instead appointing a "technical advisor" to operate entirely in secret, relying upon any "materials . . . upon which a person versed in the relevant field of knowledge would be reasonably expected to rely" ***without*** even identifying such materials to the district judge or to the parties (App. 52). The advisor was instructed "to clarify the conflicting, apparently one-sided opinions of each [party's] expert" (App. 50)—in other words, to decide the patent infringement lawsuit.

The questions presented, therefore, are these:

(1) Whether the Federal Circuit's decision to disregard Fed.R.Evid. 706 and instead to apply regional circuit law impermissibly created a situation contrary to the mandate of Congress that the patent laws be applied uniformly throughout the Nation?

(2) Whether TechSearch was denied its Seventh Amendment right to a jury trial on the factual issue of patent infringement when (a) the district court appointed *sua sponte* a Rand Corporation theoretical physicist to act as an "advisor" on microprocessor design; (b) permitted him to consider materials outside the record and to conduct secret, independent investigations relating to the case while prohibiting the parties from learning what he was doing; (c) the expert failed to follow the so-called procedural "safeguards" used to justify his appointment (d) and where (as the concurring opinion of Judge Dyk in the Federal Circuit acknowledges) the district court "may have resolved factual issues on summary judgment."

PARTIES TO THE PROCEEDING

Petitioner

Petitioner is TechSearch, L.L.C., an Illinois limited liability company which has no parents, subsidiaries or affiliates that have issued shares to the public. TechSearch was the Plaintiff in the United States District Court for the Northern District of California, and the Appellant in the United States Court of Appeals for the Federal Circuit.

Respondent

Intel Corporation is a publicly traded Delaware corporation. Petitioner is unaware of any publicly held company owning 10% or more of Intel's stock. Intel was the defendant in the United States District Court for the Northern District of California, and the defendant-cross appellant in the United States Court of Appeals for the Federal Circuit.

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OPINIONS BELOW

The opinion of the Federal Circuit is reported at 286 F.3d 1360 (App. 4-46). The opinion of the district court entering summary judgment of noninfringement (App. 75-94) is unreported. The district court's order (App. 47-66) *sua sponte* appointing the Rand Corporation's Dr. Anthony Hearn as a "technical advisor" also is unreported.

STATEMENT OF JURISDICTION

The Judgment of the Court of Appeals was entered on April 11, 2002. A timely petition for rehearing and suggestion for rehearing *en banc* was denied on June 4, 2002 (App. 1-3). The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Rule 706(a) of the Federal Rules of Evidence ("Court Appointed Experts")—which the district court disregarded, with the approval of the Federal Circuit—provides:

> (a) Appointment. The court may on its own motion or on the motion of any party enter an order to show cause why expert witnesses should not be appointed, and may request the parties to submit nominations. The court may appoint any expert witnesses agreed upon by the parties, and may appoint expert witnesses of its own selection. An expert witness shall not be appointed by the court unless the witness consents to act. A witness so appointed shall be informed of the witness' duties by the court in writing, a copy of which shall be filed with the clerk, or at a conference in which the parties shall have opportunity to participate. A

witness so appointed shall advise the parties of the witness' findings, if any; the witness' deposition may be taken by any party; and the witness may be called to testify by the court or any party. The witness shall be subject to cross-examination by each party, including a party calling the witness.

STATEMENT OF THE CASE

This case presages a fundamental change in the way patent infringement cases will be tried, at least in district courts of the Ninth Circuit, which will be permitted to use procedures explicitly forbidden to district courts of the Seventh, First, Third and D.C. circuits. The Federal Circuit's decision effectively authorizes district courts in the Ninth Circuit to abandon their gatekeeping responsibility with respect to factual evidence in patent infringement cases by appointing a "technical advisor" who, at least in this case, was given blanket authority secretly to consider "materials . . . upon which a person versed in the relevant field of knowledge would be reasonably expected to rely" ***without*** even identifying such materials to the parties or to the district judge (App. 52). That secret procedure would result in reversal in patent cases tried in the Seventh, First, Third and D.C. Circuits, in violation of the Congressional mandate to "provide nationwide uniformity in patent law," *H. R. Rep. No. 97-312*, p. 20 (1981).

Further, the secret procedure now approved for use in future patent infringement cases that happen to be tried in the Ninth Circuit is the antithesis of a jury trial on the factual issue of patent infringement, in which the jury and that district judge can consider only the factual evidence of record, and the reviewing court knows exactly what that evidence was.

Hereafter, in the Ninth Circuit, patent cases will be decided by "technical advisors" based on secret evidence

unknown to the parties and to the Federal Circuit, which will make the work of the advisor (and the district court's resulting opinion) effectively unreviewable. Neither the evidence considered; the potential biases of the "technical advisor" (in this instance, an employee of a giant, private "think tank" consulting firm); nor the thought process actually used to reach a decision will be available to the parties or to the reviewing court. And under the Federal Circuit's new rule, if a district court, with the supposed benefit of greater familiarity with the evidence than any court of review, cannot function without a "technical advisor," how can any court of review (which will be deprived of the very information needed for *de novo* review) manage to do anything more than apply a rubber stamp?

Procedural History

TechSearch, L.L.C. sued Intel Corporation in the United States District Court for the Northern District of Illinois on June 25, 1998, seeking damages for infringement of TechSearch's United States Patent No. 5,574,927, entitled "RISC Architecture Computer Configured For Emulation Of The Instruction Set Of A Target Computer" (the "'927 patent"). On August 21, 1998, the Illinois district court granted Intel's motion to transfer the case to the Northern District of California.

Well before the hearing on Intel's motion for summary judgment, the district court conducted a *Markman* claim construction exercise following the elaborate procedures set forth in Local Rules 16-10 and 16-11 of the Northern District of California. The parties submitted proposed definitions of disputed claim terms with supporting briefs and expert testimony. Comprehensive written reports were prepared by the parties' technical experts, then exhaustive depositions were taken of those experts. On August 10,

1999, the district court held a day-long *Markman* hearing, at which the parties' technical experts again testified.

The district court next interpreted the disputed terms of the claims of the '927 patent in a 32-page Memorandum Opinion and Order issued on November 1, 1999. In that decision, the district court accepted essentially all of TechSearch's proposed definitions.

The District Court's *Sua Sponte* Appointment Of A "Technical Advisor"

A month and a half before the summary judgment hearing, and without prior notice to the parties, the district court revealed that several weeks earlier it had secretly appointed its own "advisor," Dr. Anthony Hearn, a theoretical physicist, ostensibly to "assist the court" by providing technical advice on the subject of "microprocessor design" (App. 47-51). The district court's order explicitly prohibited the parties from contacting Dr. Hearn (App. 52) and stated that he was exempted from the mandatory requirements of Fed.R.Evid. 706 governing "court appointed experts" (App. 49).

The district court and its staff held a secret half-day long meeting on November 3, 1999 with Dr. Hearn, who flew to San Francisco from Santa Monica for that purpose (App. 68). Two weeks later, on November 9, 1999, the district court revealed to the parties its *sua sponte* appointment of Dr. Hearn (App. 47-53). TechSearch objected to Dr. Hearn's appointment.

The District Court's Rationale For Appointing Dr. Hearn

The district court sought to excuse its appointment of Dr. Hearn; its refusal to comply with Fed.R.Evid. 706 and its

prohibition on communication or depositions by asserting that Dr. Hearn was to act in a capacity "similar to that of a judicial clerk" (App. 53) to "acquaint the judge with the jargon and theory disclosed by the testimony and to help him think through certain of the critical technical problems that invariably arise pre-trial and during the trial" (App. 50). The appointment order also stated:

> The Court will identify for the parties materials, if any, used by Dr. Hearn in providing advice to the Court ***other than*** those submitted by the parties or ***those upon which a person versed in the relevant field of knowledge would be reasonably expected to rely.***

(App. 51-52, emphasis added). Thus, by the terms of the district court's own appointment order, Dr. Hearn was authorized to locate and consider materials outside the record without identifying such materials to the district court or to the parties; and the parties were prohibited from learning what materials were found and considered by him.

Dr. Hearn's Lack Of Pertinent Expertise

Dr. Hearn was not a person of ordinary skill in the art pertaining to TechSearch's '927 patent, under either party's definition of such a person. Dr. Hearn apparently was educated as a physicist and has since gained some experience with computers, but he has ***no*** experience or expertise in ***microprocessor design***, the subject on which he was to advise the Court as set forth in the Appointment Order (App. 51). Indeed, when the issue was raised for the purposes of the *Markman* hearing, Intel insisted that a technical expert had to be specifically acquainted with "methods for ***emulating*** the instruction set of a target computer with a RISC architecture host computer" (emphasis added). There is nothing in Dr. Hearn's biography—not one word—

to suggest he ever had any experience with any kind of emulation, let alone the very specific knowledge and experience even Intel insisted was essential just to understand the technology of this lawsuit.

Neither the district court nor the Federal Circuit panel ever addressed the fact that Dr. Hearn's "expertise" had nothing to do with the subject on which he provided secret "technical advice." Had such a person been proposed by a party, the district court would have been obligated to exclude his testimony under *Daubert* v. *Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993) and *Kumho Tire Co.* v. *Carmichael*, 526 U.S. 137 (1999).

Even more importantly, the district court's appointment order (formulated and entered without notice to the parties and over TechSearch's objection) instructed Dr. Hearn to consider "materials . . . upon which a person versed in the relevant field of knowledge would be reasonably expected to rely" (App. 52). How was Dr. Hearn to consider or even identify such materials without even knowing what would or would not be considered pertinent by a person of ordinary skill? The district court did not say, and neither did the Federal Circuit.

Dr. Hearn's "Research" And The District Court's Failure To Follow Its Own "Procedural Safeguards"

The order appointing Dr. Hearn also required that: "Dr. Hearn will execute an affidavit indicating his understanding of this Order ***prior to beginning his engagement***. He [Dr. Hearn] will ***at the conclusion of his employment*** file an affidavit attesting to his compliance with the terms of this Order" (App. 52, emphasis added). Dr. Hearn ignored both of the foregoing requirements of the Order. He did not file anything until November 9, 1999 (App. 64-66), which

was actually two weeks ***after*** he began working on the case (App. 68-69). And he never filed any affidavit "at the conclusion of his employment . . . attesting to his compliance with the terms of this Order"—he only submitted $20,000.00 worth of invoices (App. 68-71, 74).

Although Dr. Hearn attended the summary judgment hearing, no materials he considered were ever identified to the parties by the district judge or by anybody else. It was not until receipt of Dr. Hearn's invoices beginning on February 3, 2000 (App. 67-74) (almost three months after the district court's December 16, 1999 order stating that Intel's summary judgment motion would be granted) that Dr. Hearn provided any indication of what he had actually done.

Those invoices ultimately revealed that Dr. Hearn spent 54.5 hours (over a full week) doing what he called "research"—that is, independent investigation outside the courtroom—precisely what the Appointment Order prohibited him from doing. His investigations began on ***October 24, 1999*** (App. 68)—over two weeks ***before*** his official November 9, 1999 appointment by the district court (App. 47-63), and thus before the parties even knew of his existence and more than three weeks before the parties were instructed on November 17, 1999, to send him their briefs and supporting materials on the pending summary judgment motions (App. 97-98). For several weeks before the parties were informed of his existence or of his retention to work on the case and before the parties sent him the limited record he should have studied, Dr. Hearn did 5.5 hours of "research"; called the district judge from an airplane; traveled to San Francisco; conducted 4.5 hours of "research discussions with Judge and staff" and sent one or more undisclosed written communications to someone unknown to the parties and to this Court (App. 68-69).

By the time of the December 14, 1999 summary judgment hearing, Dr. Hearn had done 13.5 hours more "research"

and had conducted an entire day (seven hours on December 13-14) of "research ***discussions***" with unidentified persons (App. 70)—all in secrecy and in violation of the prohibition on such activities in the district court's order appointing him, which purported to prohibit "any independent investigation of the underlying litigation" (App. 51). Even after the December 14 hearing, Dr. Hearn did still more "research" (App. 70, App. 74).

Dr. Hearn's invoices ultimately revealed that he did not stop with "research discussions" with unidentified people. He also submitted a credit card bill that shows purchases of over $200 worth of computer equipment, software or services from three different suppliers (Best Internet Communications, Creative Computers and Fry's Electronics) on November 5-6, 1999 (App. 72), just two days after his initial meeting with the district court.

Thus, it was undisputed that Dr. Hearn violated the terms of his own appointment order by failing to execute an affidavit "prior to beginning his employment" and also by failing to file an affidavit "at the conclusion of his employment". Unable to do anything about the first of these violations, Intel was so concerned about the second that it tried to get the district court to rectify Dr. Hearn's violation *ex post facto*, months after it happened (App. 99-101). Intel's attempt to fix the unfixable went unanswered, and was ignored by the Federal Circuit.

The Federal Circuit's Approval Of The District Court's Disregard Of Fed.R.Evid. 706

The Federal Circuit, like the district court, explicitly held that Fed.R.Evid. 706 is purely advisory, not mandatory (App. 40 n.1). The Federal Circuit further asserted that "we are not convinced that the evidence suggests that Dr. Hearn conducted independent experiments or research"

(App. 44). The Federal Circuit did not even try to explain how it could have reached such a conclusion in the complete absence of any evidence that might support it—evidence the district court's order withheld from the parties and from reviewing courts. As a consequence of the district court's absolute prohibition on communications with Dr. Hearn (App. 52), and its failure to identify a single document or other material upon which he relied, the parties and this Court have no way to know (1) what documents or persons he consulted during his week and a half of "research" and his day of "research discussions," (2) what he was told or what conclusions he drew from his *ex parte* "research discussions," (3) what he told the district court based on his research, or (4) what written statements relating to the case he mailed to someone.

Based on the record below, there is also no way of knowing whether or not Dr. Hearn used only "materials . . . upon which a person versed in the relevant field of knowledge would be reasonably expected to rely," as the district court stated he was being told to do (App. 52), or what such materials were. Under the appointment order, ***not even the district judge was to be informed of Dr. Hearn's use of such off-the-record materials***. Perhaps most importantly, there is no way to tell what *ex parte* experiments or tests Dr. Hearn may have done with the computer equipment or software that he purchased within days of his secret meeting with the district court. He was simply turned loose to act as both judge and fact-finder, with no supervision whatever.

The Federal Circuit also stated: "Nor are we persuaded that the evidence establishes that Dr. Hearn's failure to certify his compliance with the order was reversible error" (App. 44). The Federal Circuit justified that conclusion by asserting that "the court exercised great care to insure that Dr. Hearn's assistance did not unduly influence the court's

consideration of the evidence"—a conclusion with which Judge Dyk disagreed (App. 44-45). The Federal Circuit also held that even though "essential" safeguards were omitted, that did not matter because "the district court appointed the technical advisor prior to the issuance of the Ninth Circuit's *en banc* opinion in *Association of Mexican-American Educators*" (App. 45). In short, the Federal Circuit paid lip service to the need for "safeguards" if a district court chooses to disregard Fed.R.Evid. 706(a), but ironically, it ended up concluding that even failure to follow the "essential" safeguards the Federal Circuit believed the Ninth Circuit had established was not reversible error! (App. 45).

REASONS FOR GRANTING THE WRIT OF CERTIORARI

Petitioner seeks review because under the decision of the Federal Circuit, whether or not a "technical advisor" can be imposed upon the parties and used in secret "to clarify the conflicting, apparently one-sided opinions of each [party's] expert" (App. 50)—in other words, to decide patent infringement lawsuits—will depend on the circuit in which the district court sits, and will be reached in complete disregard of the uniform, nationwide procedure set forth in the Federal Rules of Evidence governing the use of such "advisors." The Federal Circuit's holding directly conflicts not only with Fed.R.Evid. 706(a) (which contains no exception excusing district judges from complying with it when they feel like ignoring its requirements), but also with the purpose for which the Federal Circuit was created: to increase doctrinal stability in the field of patent law.

Further, the Federal Circuit's decision authorizes district courts (at least in the Ninth Circuit) to appoint "technical advisors" who will work entirely in secret at the judge's elbow, using any materials from outside the record that the advisor wishes to consider, without informing the parties

and without even satisfying the most basic requirement for an expert in a patent case of possession of ordinary skill in the relevant art. Survey evidence from cases in which (unlike here) the court-appointed "expert's" advice was not concealed from review demonstrates that the "advice" of such court-appointed "experts" is essentially always case-dispositive:

> The court-appointed expert often has a great impact on the outcome of the case. Not surprisingly, both judges and juries appear to decide cases in a manner that is consistent with the testimony of the court-appointed expert. ***In a study of 58 cases with court-appointed experts, only two resulted in decisions that were inconsistent with the position of the court-appointed expert.*** And those two cases were bench trials in which the judges based their decisions upon legal analysis that was independent of the technical issues about which the expert testified.

Cynthia H. Cwik, "Guarding the Gate: Expert Evidence Admissibility," *LITIGATION*, Vol. 25, No. 4, at p. 66 (Summer 1999) (emphasis added).

Is this Court prepared to permit patent cases to be decided using procedures disregarding the mandatory, uniform, nationwide provisions of the Federal Rules of Evidence? Can patent cases in the Ninth Circuit be decided not on the evidence presented to the district judge or to a jury, but on independent investigations made by admittedly unqualified "technical advisors" co-opted for the purpose from major private corporations such as the Rand Corporation—advisors who work entirely in secret, accountable to no one? Should this Court approve consultation with an "advisor" who violates even minimal procedural "safeguards" and whose work is entirely insulated not only from any appellate review, but even from the "gatekeeping"

requirements of *Daubert* and *Kumho Tire*? Unless this Court agrees with those procedures—and with their limitation to the Ninth Circuit, thus Balkanizing patent lawsuit decisions—the Federal Circuit's decision must be reversed.

I. THE FEDERAL CIRCUIT'S DECISION DIRECTLY CONTRADICTS FED.R.EVID. 706 AND THE MANDATE OF CONGRESS IN CREATING THE FEDERAL CIRCUIT

A. Congress Mandated Uniformity In Application Of The Patent Statute

The Federal Circuit was created to ensure doctrinal stability in the patent law. "Congress conferred exclusive jurisdiction of all patent appeals on the Court of Appeals for the Federal Circuit, in order to 'provide nationwide uniformity in patent law.' *H. R. Rep. No. 97-312*, p. 20 (1981)." *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989). The purpose of the Federal Circuit's enabling act, the Federal Courts Improvement Act of 1982, Pub. L. 97-164, 96 Stat. 25, is to provide:

> [A] forum that will increase doctrinal stability in the field of patent law. Based on the evidence it had compiled, the Hruska Commission singled out patent law as an area in which the application of the law to the facts of a case often produces different outcomes in different courtrooms in substantially similar cases. Furthermore, in a Commission survey of practitioners, the patent bar indicated that uncertainty created by the lack of national law precedent was a significant problem . . . .
>
> * * * *
>
> The testimony received by the committee also supported the basic objective of providing for uniformity of doctrinal development in the patent area.

* * * *

> The creation of the Court of Appeals for the Federal Circuit will produce desirable uniformity in this area of the law.

S. Rep. 97-975, 97th Cong., 1st Sess. 5, reprinted in *1982 U.S. Code Cong. & Ad. News* 15.

> [The Federal Circuit] is charged with the duty of increasing doctrinal stability in the field of patent law. See generally *S. Rep. No. 97-275, 97th Cong., 2d Sess., 2-7*, reprinted in *1982 U.S. Code Cong. & Ad. News* 11, 12-17. Congress indicated that its grant of exclusive jurisdiction should not be manipulated:
>
> > This measure is intended to alleviate the serious problems of forums [sic] shopping among the regional courts of appeals on patent claims by investing exclusive jurisdiction in one court of appeals. It is not intended to create forum shopping opportunities between the Federal Circuit and the regional courts of appeals on other claims.
>
> *Id.* at 19-20, 1982 *U.S. Code Cong. & Ad. News* at 29-30.

Chemical Engineering Corp. v. *Marlo, Inc.*, 754 F.2d 331, 333 (Fed. Cir. 1984). In fact, "one of the fundamental purposes behind the Patent and Copyright Clauses of the Constitution was to promote national uniformity in the realm of intellectual property. See *The Federalist* No. 43, p. 309 (B. Wright ed. 1961)." *Bonito Boats*, 489 U.S. at 162.

B. The Regional Circuits Are Split Concerning The Procedures For *Sua Sponte* Appointments Of "Technical Advisors"

In this case, the Federal Circuit panel held that the use of a "technical advisor" was controlled by regional circuit law, see App. 37, notwithstanding the split between regional circuits regarding the use of court-appointed "technical advisors." Relying on the *en banc* decision in *Association of Mexican-American Educators* v. *California*, 231 F.3d 572, 591 (9th Cir. 2000), a decision entered two years ***after*** the district court's actions in this case and even after appellate briefing was completed, the Federal Circuit concluded that in the Ninth Circuit, district judges have "inherent authority" to select and appoint "technical advisors" without even consulting the parties and in complete disregard of the procedural requirements of Fed.R.Evid. 706. The Federal Circuit held that (in the Ninth Circuit) district judges can confer with such advisors in secret and without making any record of their activities; explicitly authorize such advisors to consult and rely upon undisclosed materials outside the record; and prohibit the parties from learning what such advisors do and say. And, according to the Federal Circuit, it does not even matter if such advisors violate the so-called "safeguards" which may or may not be imposed at the judge's whim, and induce the judge to resolve disputed factual issues on summary judgment.

The Federal Circuit also cited *Reilly* v. *United States*, 863 F.2d 149 (1st Cir. 1988), a medical malpractice case. But, in *Reilly* (unlike this case), there was no belated evidence (surfacing months after a decision was reached) of secret investigations done by the expert and secret meetings with the district court (App. 68-71). And of course, neither *Reilly* nor *Mexican-American Educators* implicated the Congressional mandate for uniformity in the application of the patent statute.

Moreover, the Federal Circuit ignored the subsequent decision in *United States* v. *Craven*, 239 F.3d 91 (1st Cir. 2001), in which the First Circuit vacated a sentence that was based in part upon a one-hour *ex parte* communication between the district judge and a court-appointed "expert" psychologist who (as in this case) was insulated from contact with the parties:

> In general, the law frowns upon ex parte communications between judges and court-appointed experts. See *Bradley v. Milliken, 620 F.2d 1143, 1158 (6th Cir. 1980)* (expressing concern that reports of court-appointed experts were not placed in record or made available to parties); *United States v. Green, 544 F.2d 138, 146 n.16 (3d Cir. 1976)* ("Generally . . . the court should avoid *ex parte* communications with anyone associated with the trial, even its own appointed expert."); see generally 29 Charles Alan Wright et al., *Federal Practice and Procedure* § 6305 (1997 & Supp. 2000) ("Ex parte communications between the judge and the expert . . . are discouraged."). The reason is obvious: most ex parte contacts between a trial judge and another participant in the proceedings risk harm, and ex parte communications with key witnesses (such as court-appointed experts) are no exception. To the contrary, such ex parte contacts can create situations pregnant with problematic possibilities.

Craven, 239 F.3d at 102. Just as in this case, in *Craven*, there was no statutory provision authorizing "substantive *ex parte* communications between the appointer and the appointee." *Id.* As the First Circuit held, prohibiting *ex parte* communications

> fits neatly with the prevailing view as to how courts should communicate with court-appointed experts on matters of substance. E.g., *Bradley, 620 F.2d at*

> *1158* (opining that "if any experts are employed to advise the district court . . . they shall prepare written reports, copies of which shall become part of the record and shall be made available to all parties or their attorneys"); *Green, 544 F.2d at 146 n.16* (observing that the most appropriate way for a court to talk with its appointed expert would be through "an on-the-record conference in chambers or an on-the-record conference call so that counsel for all parties may participate"); Joe S. Cecil & Thomas E. Willging, *Court-Appointed Experts: Defining the Role of Experts Appointed Under Federal Rule of Evidence 706*, at 91-92 (1993) ("If the judge and the expert expect to confer in person . . . representatives of the parties can be invited to attend the conference or . . . a record of the discussion can be forwarded to the parties.").

Craven, 239 F.3d at 102.

The Federal Circuit's grant of permission to do these things in the Ninth Circuit is entirely at odds with the law in other circuits. In addition to the First Circuit's *Craven* decision, for example, the Seventh Circuit also has held that independent, *ex parte* investigations of evidence, like the week and a half of "research" and "research discussions" and possible experiments Dr. Hearn conducted with software purchased two days after his initial meeting with the district court constitutes reversible error of such a serious nature that it requires not only reversal of the district court's decision but also disqualification of the district judge who permitted such conduct. In *Edgar* v. *K.L.*, 93 F.3d 256 (7th Cir. 1996), for example, the district judge appointed a panel of three experts to investigate the mental health care system of Illinois. Unlike this case, the parties had actually consented to a procedure that permitted the panel's members and aides to meet with patients and state

employees outside the presence of counsel, on the theory that reliable data could not be obtained in some other fashion. *Edgar*, 99 F.3d at 257. Later, the panel began to meet in private with the judge. One such meeting, on September 7, 1994, lasted 3½ hours and was dedicated to giving the judge a preview of the panel's conclusions and methodology. *Id.* (Compare the 4.5 hours that Dr. Hearn spent in "research discussions with Judge and staff" in this case on November 3, before the district court even revealed Dr. Hearn's appointment (App. 68), and the one and a half weeks of "research" and "research discussions" that followed in this case (App. 68-74).) In *Edgar*, just as in this case, the district court prohibited any inquiry into its discussions with the court-appointed experts. *Edgar*, 93 F.3d at 258.

On petition for a writ of mandamus, the Seventh Circuit reversed, and also disqualified the district judge. *Edgar*, 93 F.3d at 262. Noting that because of the district court's prohibition on discovery from the court-appointed experts, "all we have are possibilities," *id.* at 258, the Seventh Circuit reasoned that it, too, had been improperly shielded from the decision-making process:

> Did any meeting between judge and experts touch the merits, or procedures affecting the merits? We cannot know, because the district judge has blocked discovery from other participants and has declined to state on the record his own memories of what happened.

Id. Such evidence as there was from a meeting agenda suggested that, just as in this instance, the panel of experts discussed with the district judge "subjects at the core of the litigation." *Id.*

Holding that any consent by the parties was ineffectual, *Edgar*, 93 F.3d at 258, the Seventh Circuit went on to conclude that:

> ***Rule 706(a) of the Federal Rules of Evidence specifies the right way***: . . . This places the substance of the instructions on the record and ensures that the parties know what is happening and can make appropriate suggestions, motions, and objections. ***The judge has not attempted to reconcile with Canon 3A(4) or Rule 706(a) the procedure he used in this case.***

Id. at 259 (emphasis added).

> The point of distinguishing between "personal knowledge" and knowledge gained in a judicial capacity is that information from the latter source enters the record and may be controverted or tested by the tools of the adversary process. Knowledge received in other ways, which can be neither accurately stated nor fully tested, is "extrajudicial." . . . ***Off-the-record briefings in chambers, by contrast, leave no trace in the record***—and in this case the judge has forbidden any attempt at reconstruction. ***What information passed to the judge, and how reliable it may have been, are now unknowable. This is "personal" knowledge no less than if the judge had decided to take an undercover tour of a mental institution to see how the patients were treated.*** Instead of going himself, this judge appointed agents, who made a private report of how they investigated and what they had learned. ***Mandatory disqualification under § 455(b)(1) follows.***

Id. (emphasis added). The First Circuit in *Craven*, too, held that a district judge who engages in substantive *ex parte* communications touching on the merits of the case is disqualified from conducting any further proceedings:

> The Seventh Circuit's rationale applies here. When a judge receives information that does not enter the

> record, the reliability of that information may not be tested through the adversary process. *Id. at 259* (noting that "off-the-record briefings . . . leave no trace in the record" and "what information passed to the judge, and how reliable it may have been, are now unknowable"). Moreover, it is difficult, if not impossible, for a judge, no matter how sincere, to purge that information from her mind—and, equally, to maintain the perception of impartiality.

Craven, 239 F.3d at 103.

In the D.C. Circuit and the Third Circuit, too, the approach adopted by the Ninth Circuit and the Federal Circuit has been rejected. The district court here sought to justify its appointment of Dr. Hearn by asserting that "this is a highly technical case" (App. 48) because "the '927 patent is highly technical" (App. 47 n.1)—a justification the Federal Circuit panel accepted (App. 43). But, as the D.C. Circuit has held, complexity actually ***increases*** the need that the district judge himself (not an outsider from a private company) address the issues:

> [I]t is very doubtful that complexity tends to legitimate references to a master at all. *La Buy* [*v. Howes Leather Co.*, 352 U.S. 249 (1957)] noted that the complexity of an antitrust case, rather than justifying a reference, "is an impelling reason for trial before a regular, experienced trial judge rather than before a temporary substitute appointed on an *ad hoc* basis and ordinarily not experienced in judicial work." *Id.* at 259.

United States v. *Microsoft Corp.*, 147 F.3d 935, 955 (D.C. Cir. 1998). See also, e.g., *Alexander* v. *FBI*, 186 F.R.D. 128, 132-33 (D.D.C. 1998) (refusing request for appointment of special master in White House "filegate" investigation despite government's allegations of complex issues); *Bennerson* v. *Joseph*, 583 F.2d 633, 641-42 (3d Cir. 1978) (district

court violated *La Buy* by referring an entire case dealing with validity of land conveyances to a special master; case remanded with instructions that district judge himself must conduct a trial and make findings of fact).

In *Microsoft*, the district court appointed a "special master" to assist it in resolving complex technical issues relating to allegations of contempt of a consent decree. *United States* v. *Microsoft Corp.*, 980 F.Supp. 537, 545-46 (D.D.C. 1997). The D.C. Circuit held the trial court lacked authority to appoint what, in effect, was "a surrogate judge":

> In short, when we said in *Bituminous Coal* [*Operators' Ass'n, 292 U.S. App. D.C. 309, 949 F.2d 1165, 1168 n.4 (D.C. Cir. 1991)*] that ***we were granting the writ "not because the district judge simply abused his discretion, but because he has no discretion to impose on parties against their will 'a surrogate judge,'"*** id. at 1168 (citations omitted), we effectively ruled out nonconsensual references in nonjury cases except as to peripheral issues such as discovery and remedy.

Microsoft, 147 F.3d at 956 (emphasis added). That court-appointed experts do function as surrogate judges is beyond serious question, in view of the survey results cited above. Such an appointment could ***never*** be justified, the D.C. Circuit held, because of the existence of the alternate mechanism of Rule 706 for providing assistance with "highly technical" issues:

> To the extent that adjudication may lead the court into deep technological mysteries, we note the court's power ***under Rule of Evidence 706*** to appoint expert witnesses. Whether such an expert is appointed by agreement of the parties or not, ***the expert's exposure to cross-examination by both sides, see Rule 706(a), makes the device a far***

> ***more apt way of drawing on expert resources than the district court's unilateral, unnoticed deputization of a vice-judge.***

Microsoft, 147 F.3d at 955 n.22 (emphasis added).

The district court's actions in this case parallel those that led to the D.C. Circuit's holding in *Microsoft* that appointment of a "surrogate judge" was an abuse of discretion or an unconstitutional abdication of the responsibility to decide cases. *Id.* at 954-56. Here (just as in *Microsoft*), the district court justified its appointment of Dr. Hearn on the basis of the alleged "highly technical" nature of the case (App. 47-48, App. 50)—and here, just as in *Microsoft*, the district court did not follow the procedures mandated by Fed.R. Evid. 706, thus denying the parties (and this Court) the safeguards provided by that Rule. Indeed, the district court here went out of its way to ***prohibit*** any recourse to the safeguards of Fed.R.Evid. 706 (App. 51-52). And unlike the "special master" in the *Microsoft* case, Dr. Hearn was not even required to make "proposed findings of fact and conclusions of law" which the parties and this Court could review. See, e.g., *General Electric Co.* v. *Joiner*, 522 U.S. 136, 151 (1997) (Stevens, J., concurring and dissenting, stating that where an expert relies on materials outside the record, a fair appraisal of methodology or conclusions on appeal may be thwarted). The abdication of judicial authority and responsibility was even more complete here than in *Microsoft*.

In this instance, too, the conduct of Dr. Hearn (which the district court authorized) was even more egregious than that of the panel of experts in the *Edgar* case, and of the advisor in *Craven*. Dr. Hearn conducted his own *ex parte* investigations and conferences and communicated the results (whatever they were) to the district judge, both orally and (apparently) in writing. Further, he may have conducted experiments of some sort using unidentified

computer equipment or software. The time he spent in independent investigation and in conference with the district court exceeds that in the *Edgar* case by a factor of ten. And the time spent in *ex parte* communication with the district court far exceeded the one hour that was found improper in *Craven*. Worse, Dr. Hearn began his secret experiments and communications with the district court well before the parties were made aware of his existence (A7631).

In short, had a district judge in the Seventh Circuit or the First Circuit done what the Federal Circuit says district judges in the Ninth Circuit are permitted to do, that judge not only would have been reversed, he also would have been disqualified. The Congressional mandate for uniform application of the patent statute is directly violated.

C. The Federal Circuit's "Analysis" Does Not Even Acknowledge The Problems Created By Permitting Disregard Of Fed.R.Evid. 706

The Federal Circuit's panel apparently somehow inferred that Dr. Hearn must have merely studied the briefs and exhibits of record (even though the district judge explicitly authorized him to go outside the record) (App. 43-44). But, no evidence supports such a speculation, because the district court prohibited any inquiry. And that hypothesis—for it is no more—does not explain Dr. Hearn's 8.5 hours of "research" ***before*** he even was sent the briefs and exhibits (App. 68-69). Because he provided no report of what he actually did, there is no way of knowing precisely what Dr. Hearn meant by "research." As a scientist, however, he must have known the word "research" can mean "investigation or experimentation aimed at the discovery and interpretation of new facts," Webster's *Ninth New Collegiate Dictionary* (1986)—exactly what is absolutely prohibited in the Seventh, First, Third and D. C. Circuits.

The district court sought to excuse its refusal to comply with Fed.R.Evid. 706 (the application of which would have answered all the questions about what Dr. Hearn did) by characterizing him as a sort of "technical clerk" said to be "similar to . . . a judicial clerk" (App. 53) in that he was not to conduct any independent investigations. But in fact, he did conduct such investigations (which may account for his failure to affirm that he did not do so after completing his work). Moreover, his work was not merely to translate technical jargon, but also (according to the appointment order itself) "to clarify the conflicting, apparently one-sided opinions of each [party's] expert" (App. 50)—in other words, to do what the district judge ought to have been doing, with the open, public assistance of the parties' experts. The notion that a "technical advisor" does not consider evidence, and therefore should be excused from the requirements of Fed.R.Evid. 706, is not only lacking in support in the Federal Rules; it is completely illusory in the real world. Indeed, Fed.R.Evid. 706 would be entirely superfluous if district courts can disregard it merely by relabeling an "expert" as a "technical advisor," as district courts in the Ninth Circuit now have been authorized to do in patent cases.

D. The Split Between Circuits Cannot Be Ignored

Under the Federal Circuit panel's decision in this case, a district judge in the Ninth Circuit can decide *sua sponte* that a patent infringement case is "highly complex" as justification for imposing on the parties a "technical advisor" chosen by the Court to "clarify the conflicting, apparently one-sided opinions of each [party's] expert" (App. 50)—in other words, to decide the patent infringement lawsuit. And the advisor's work can be secret and can involve consideration of unidentified materials outside the record. But, if a district judge in the First Circuit, the

Seventh Circuit, the D.C. Circuit or the Third Circuit does such a thing, he will be reversed—and in the Seventh and First Circuits he'll be disqualified to boot.

Such a gross disagreement between circuit courts of appeal would justify granting certiorari in the context of any area of substantive law. Federal judges in all circuits are supposed to follow the same procedures and apply the same rules of evidence—including Fed.R.Evid. 706, which judges in the Ninth Circuit are now permitted to disregard. But review by this Court is especially necessary in light of the Congressional mandate to "provide nationwide uniformity in patent law," *H. R. Rep. No. 97-312*, p. 20 (1981) and to prevent "different outcomes [in patent lawsuits] in different courtrooms in substantially similar cases," *S. Rep. 97-975, 97th Cong., 1st Sess. 5*. The Federal Circuit panel's decision does exactly the opposite, thus conflicting with the "fundamental purposes behind the Patent and Copyright Clauses of the Constitution . . . to promote national uniformity in the realm of intellectual property," *Bonito Boats*, 489 U.S. at 162.

II. THE FEDERAL CIRCUIT'S DECISION ABRIDGES THE CONSTITUTIONAL GUARANTEE OF A JURY TRIAL OF THE FACTUAL ISSUE OF PATENT INFRINGEMENT

The Federal Circuit panel here affirmed the district court's entry of summary judgment on the factual issue of noninfringement in the face of the concern expressed by Judge Dyk that "I think that the district court's infringement analysis may have been too heavily influenced by the technical advisor, and that the district court may have resolved factual issues on summary judgment" (App. 46). The Federal Circuit panel in this case even conceded that "the procedures followed by the district court fell somewhat short of those essential to avoiding such influence" (App.

45). Survey evidence shows that Judge Dyk's concern was fully justified—the "advice" of court appointed experts decides the case. Cynthia H. Cwik, "Guarding the Gate: Expert Evidence Admissibility," *LITIGATION*, Vol. 25, No. 4, at p. 66 (Summer 1999).

Judge Dyk's conclusion was an understatement. Here, the district court explicitly authorized the "technical advisor" it had imposed upon the parties to select and to consider, in secret, any "materials . . . upon which a person versed in the relevant field of knowledge would be reasonably expected to rely" ***without*** even identifying such materials to the parties (App. 52). And the "expert" so empowered was not even a person of ordinary skill in the pertinent art, as shown above.

District courts have a mandatory "gatekeeping" function imposed by the Federal Rules of Civil Procedure in deciding whether allegedly "expert" opinions—as opposed to evidence supplied by those with knowledge of the facts—can be considered in reaching a decision. *Kumho Tire*, 526 U.S. at 147 ("In *Daubert*, this Court held that Federal Rule of Evidence 702 imposes a special obligation upon a trial judge to 'ensure that any and all scientific testimony . . . is not only relevant, but reliable.' "). That is because "[u]nlike an ordinary witness, an expert is permitted wide latitude to offer opinions, including those that are not based on firsthand knowledge or observation. Presumably, this relaxation of the usual requirement of firsthand knowledge—a rule which represents a most pervasive manifestation of the common law insistence upon the most reliable sources of information—is premised on an assumption that the expert's opinion will have a reliable basis in the knowledge and experience of his discipline." *Daubert*, 509 U.S. at 592.

Here, the district judge professed himself unable to deal with "the parties' voluminous evidence in fields with which the Court is not familiar" (App. 50). The Federal Circuit

panel said that "[i]n this case, the court specifically noted that evaluation of the prior art required it to consider and understand complex technical concepts beyond normal technical and scientific facts regularly addressed by the district court" (App. 38). Evaluation of prior art references, of course, depends upon possession of ordinary skill in the art. See, e.g., *Rockwell International Corp.* v. *United States*, 147 F.3d 1358, 1366 (Fed. Cir. 1998). Yet, in order to "clarify the conflicting, apparently one-sided opinions of each [party's] expert" (App. 50), the district judge sought out and hired a "technical advisor" who could never have been qualified as an expert under *Daubert* and *Kumho Tire*, since (unlike the parties' experts) he lacked ordinary skill in the pertinent art!

Astonishingly, the Federal Circuit panel speculated that the district judge used Dr. Hearn himself "to properly discharge its gatekeeper role of determining the admissibility of technical evidence" (App. 38-39). But, even proponents of increasing the role of court-appointed "experts" recognize the essential nature of the ***district court's*** "gatekeeping" function:

> Of course, neither the difficulty of the task nor any comparative lack of expertise can excuse the judge from exercising the "gatekeeper" duties that the Federal Rules impose—determining, for example, whether particular expert testimony is reliable and "will assist the trier of fact," Fed. Rule Evid. 702, or whether the "probative value" of testimony is substantially outweighed by risks of prejudice, confusion or waste of time. Fed. Rule Evid. 403. To the contrary, when law and science intersect, those duties often must be exercised with special care.

General Electric, 522 U.S. at 148 (Breyer, J., concurring). To employ an admittedly unqualified "advisor" to "assist"

the court in secret with that mandatory gatekeeping function makes no sense at all. Indeed, it is an exercise in asking the fox to guard the chickens, especially where (as here) the "gatekeeper" was deciding on the admissibility of his own advice and on whether secret materials undisclosed to the parties or even to the district court were to inform (or even control) that advice. The district court's abdication of its responsibility could not have been more complete. And the Federal Circuit decision authorizes other district judges in the Ninth Circuit to do likewise, in direct conflict with the rules in the Seventh, First, Third and D.C. Circuits.

Nor does the propriety of the procedure the Federal Circuit approved in this case turn on the precise level of Dr. Hearn's technical skill. If he was highly skilled (which the limited evidence available shows he was not), then the Federal Circuit's (and the Ninth Circuit's) procedure poses an unacceptable risk that district courts will rely on off-the-record, secret information. On the other hand, if he was unskilled, he may make mistakes that the district court will not detect, and about which the parties will not even be informed.

If Dr. Hearn performed a gatekeeping function in determining the admissibility of technical evidence, as the Federal Circuit speculated the Appointment Order authorized him to do, he was unqualified by reason of lack of ordinary skill in the pertinent art and his acts contravened *Daubert* and *Kumho Tire*. On the other hand, if instead he performed a judicial function "analogous to a law clerk," the appointment of such a "surrogate judge" was legal error. *Microsoft*, 147 F.3d at 956. Perhaps worst of all, the district judge tried to make it ***unreviewable*** error, since Dr. Hearn's acts were concealed from the parties, from the Federal Circuit and from this Court by the district court's Appointment Order (App. 51-52). The end result was that the district court was induced improperly to resolve factual

issues on summary judgment, as Judge Dyk recognized (App. 46). Indeed, the Federal Circuit panel actually went even further than the Ninth Circuit in *Mexican-American Educators* by holding not only that Fed.R.Evid. 706 can be disregarded at will, but also that violations of procedural "safeguards" purporting to justify disregarding that rule are of no moment. As a result, TechSearch was denied its Constitutional right to a jury trial on the factual issue of patent infringement.

CONCLUSION

The procedure approved by the Federal Circuit in this case will lead to the very evils Congress sought to avert by creating the Federal Circuit: forum shopping in search of a district court that will permit or prohibit the use of "technical advisors" and secret, off-the-record evidence in deciding patent infringement cases. For that reason, reversal is even more important than in the ordinary case of a split in authority between regional circuit courts of appeal—though such a split is pronounced in this instance, with the Ninth Circuit and the Federal Circuit on one side and the Seventh, First, Third, and D.C. Circuits on the other.

Tellingly, even some judges of the Ninth Circuit have expressed unease with the procedure approved by the Federal Circuit's panel decision here. Dissenting from the *Mexican-American Educators en banc* decision, Judge Tashima of the Ninth Circuit wrote:

> In some important respects, a technical advisor is quite unlike a law clerk. A law clerk's function is to aid the judge in researching legal issues in cases pending before the court. Because the judge is an expert in the law and fully understands legal

> theory and analyses, it is unlikely, to say the least, that a law clerk will impermissibly usurp the judicial function. On the other hand, a technical advisor is brought in precisely because the judge is not familiar with the complex, technical issues presented in the case. There is therefore an understandable concern that the technical advisor's opinion will carry undue weight with the judge. Cf. *Daubert, 509 U.S. at 595* (noting that "expert evidence can be both powerful and quite misleading because of the difficulty in evaluating it") (internal quotations and citation omitted). ***In short, a judge can filter out "bad" legal advice or research from a law clerk; he or she is ill-equipped, however, to do the same with "bad" technical advice.*** Moreover, resolution of legal issues is committed to the judge *qua* judge and is subject to de novo review. ***On the other hand, factual issues, no matter how technical, are committed to the factfinder and, to be reviewed properly, must be based on the record made in the trial court.***
>
> Whatever method the court employs in making a record of the technical advisor's advice and counsel, there is no reason why a neutral technical advisor's advice should be shrouded in absolute secrecy. ***Concealing the nature of that expert advice can only erode confidence in the court's role as a neutral and independent decisionmaker.***

Mexican-American Educators, 231 F.3d at 613-14 (Tashima, J., dissenting) (citations and footnotes omitted).

The solution, of course, is simply recognition that Fed. R.Evid. 706 is mandatory, rather than merely a "wish list" that district courts can disregard at will whenever they

think their job has become too difficult. That alone will resolve the circuit split, and ensure uniform application of the patent statute—the purpose for which the Federal Circuit was created. Thus, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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